

ESTTA Tracking number: **ESTTA316418**

Filing date: **11/12/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|--|
| Name | MAJOR WIRE INDUSTRIES LTD. / LES INDUSTRIES FIL METALLIQUE MAJOR LTEE |
| Granted to Date of previous extension | 11/14/2009 |
| Address | 225, Montcalm Nord Blvd. Candiac, QC J5R 3L6 CANADA |
| Domestic Representative | Jane F. Collen COLLEN IP INTELLECTUAL PROPERTY LAW, P.C. 80, South Highland Avenue The Holyoke-Manhattan Building Ossining-on-Hudson, NY 10562 UNITED STATES sboucher@mmflegal.com, dbolduc@mmflegal.com, jacollen@collenip.com Phone:914-941-5668 |

Applicant Information

| | | | |
|--------------------------------|--|---------------------------------|------------|
| Application No | 79064920 | Publication date | 09/15/2009 |
| Opposition Filing Date | 11/12/2009 | Opposition Period Ends | 11/14/2009 |
| International Registration No. | 0992163 | International Registration Date | 11/24/2008 |
| Applicant | Deutsche Edelstahlwerke GmbH Auestrasse 4 58452 Witten GERMANY | | |

Goods/Services Affected by Opposition

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|--|
| Class 006. All goods and services in the class are opposed, namely: Unwrought and semi-wrought common metals, in particular steel, stainless steel and bright steel; semi-finished products of steel in the form of rods, plates, sheets, billets, blocks, wire profiles, rings; auxiliary welding materials of metal, namely, metal welding rods, welding wire |
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Grounds for Opposition

| | |
|--------------------------------------|-----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Mark Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2606393 | Application Date | 11/12/1999 |
| Registration Date | 08/13/2002 | Foreign Priority Date | NONE |
| Word Mark | OPTIMUMWIRE | | |
| Design Mark | OptimumWire | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 006. First use: First Use: 1999/01/15 First Use In Commerce: 1999/01/15 Wires made of metal and wires made primarily of metal alloys, plastics and composites, namely, straight wires, pre crimped wires and metal sections for use in the manufacture of wire netting, wire mesh, sifting screens, sieves and filters for sifting, filtering and sieving the rock, sable, gravel, minerals, and for use in the manufacture of various industrial products; woven wire screens of straight wire, pre-crimped wire, metal section made of metal and wires made primarily metal alloys, plastics and composites, namely, wire netting and wire mesh, sifting screens, sieves, filters for use of sifting, filtering and sieving the rock, sable, gravel, minerals used in the composition of various industrial products</p> <p>Class 042. First use: First Use: 1999/01/15 First Use In Commerce: 1999/01/15 Custom manufacture of woven wire screens of straight wires, pre-crimped wire, metal section; wire netting, wire mesh, sifting screens, sieves, and filters for use in sifting, filtering or sieving the rock, sable, gravel, minerals, and used in the composition of various industrial products</p> | | |

| | |
|---------------------|------|
| Related Proceedings | None |
|---------------------|------|

| | |
|-------------|---|
| Attachments | 75848117#TMSN.gif (1 page)(bytes) Opposit Notice MajorWire_TM Optidur SN_79064920_ final_signee cli Nov12,2009.pdf (5 pages)(88479 bytes) Current printout - U.S. Registration #2606393 (tm Optimumwire).PDF (2 pages)(51879 bytes) Tarr Status- U.S. Registration #2606393 (tm Optimumwire).pdf (3 pages)(27424 bytes) |
|-------------|---|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|-------------------------|
| Signature | /Jean Leblond/ |
| Name | Jean Leblond, President |
| Date | 11/12/2009 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark
Application Serial No., 79/064,920
Filing Date: November 24, 2008
Mark: OPTIDUR
Published for opposition: September 15, 2009

MAJOR WIRE INDUSTRIES LTD. / LES INDUSTRIES
FIL MÉTALLIQUE MAJOR LTÉE,

Opposer.

Opposition No. _____

v.

DEUTSCHE EDELSTAHLWERKE GmbH

Defendant

Opposer, MAJOR WIRE INDUSTRIES LTD. / LES INDUSTRIES FIL MÉTALLIQUE MAJOR LTÉE (hereinafter "MAJOR"), believes that is or will be damaged by U.S., Federal Application Serial No. 79/064920 filed with the U.S. Patent and Trademark Office (hereinafter "USPTO") on November 24, 2008 by Defendant DEUTSCHE EDELSTAHLWERKE GmbH (hereinafter "Defendant") for the trademark OPTIDUR in connection with "Class 006. *Unwrought and semi-wrought common metals, in particular steel, stainless steel and bright steel; semi-finished products of steel in the form of rods, plates, sheets, billets, blocks, wire profiles, rings; auxiliary welding materials of metal, namely, metal welding rods, welding wire*" , in International Class 006.

MAJOR hereby opposes said application.

As grounds for the Opposition, it is alleged that:

1. MAJOR is a company incorporated in virtue of Part 1A of the Quebec Companies Act with a principal place of business at 225, Blvd, Montcalm Nord, Candiac, Quebec Canada J5R 3L6.

2. MAJOR is the owner of longstanding trademark rights in its OPTIMUMWIRE mark, and is the owner of U.S. Registration No. 2,606,393 for the OPTIMUMWIRE mark, registered in connection with : i) Wires made of metal and wires made primarily of metal alloys, plastics and composites, namely, straight wires, pre crimped wires and metal sections for use in the manufacture of wire netting, wire mesh, sifting screens, sieves and filters for sifting, filtering and sieving the rock, sable, gravel, minerals, and for use in the manufacture of various industrial products; woven wire screens of straight wire, pre-crimped wire, metal section made of metal and wires made primarily metal alloys, plastics and composites, namely, wire netting and wire mesh, sifting screens, sieves, filters for use of sifting, filtering and sieving the rock, sable, gravel, minerals used in the composition of various industrial products in IC 006. US 002 012 013 014 023 025 050 (FIRST USE: 19990115. FIRST USE IN COMMERCE: 19990115) and in connection with: ii) Custom manufacture of woven wire screens of straight wires, pre-crimped wire, metal section; wire netting, wire mesh, sifting screens, sieves, and filters for use in sifting, filtering or sieving the rock, sable, gravel, minerals, and used in the composition of various industrial products in IC 042. US 100 101 (FIRST USE: 19990115. FIRST USE IN COMMERCE 19990115) (the "Registration"). The Registration is valid and subsisting. Current printout from the official electronic database records of the USPTO summarizing the Registration is attached hereto as Attachment "A" and hereby made a part of this record.

3. The mark has been allowed, proceeded to registration on August 13, 2002 and subsequently attained *incontestable* status under Section 15 of the Lanham Act (15 U.S.C. § 1065) on September 13, 2008 upon the USPTO's formal acceptance of the combined Section 8 and 15 Affidavits.

4. MAJOR's OPTIMUMWIRE mark has been used in commerce since at least as

early as January 15, 1999.

5. MAJOR's customers and the public in general have come to know and recognize the OPTIMUMWIRE mark and associate the same with MAJOR and Major has thus built up extensive and invaluable goodwill in connection with the sale of goods under its famous mark.

6. Notwithstanding MAJOR's ownership of the Registration prior to Defendant's filing date of November 24, 2008 and MAJOR's use of the OPTIMUMWIRE mark at common law since at least as early as January 15, 1999 and prior to Defendant's filing date of November 24, 2008, Defendant filed a request for extension of protection to the United States, Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f for registration of the trademark OPTIDUR. Said application was assigned Serial No. 79/064920. There is therefore, no issue as to priority as MAJOR enjoys prior rights.

7. In view of the similarity of the respective marks in appearance and connotation and the similar nature of the goods of the respective parties, Defendant's mark so resembles MAJOR's OPTIMUMWIRE trademark, as to be likely to cause confusion and mistake, deceive the Public, injure and damage MAJOR and the Goodwill and reputation symbolized by MAJOR's OPTIMUMWIRE mark, and raise a considerable risk of consumer confusion as to the affiliation of MAJOR and Defendant. Defendant's mark and the Application are also diluting or will dilute the inherent distinctiveness of MAJOR's OPTIMUMWIRE trademark and the goodwill associated therewith in violation of 15 U.S.C. 1125(c)

8. The Federal Registration identified above provided, at the very least, constructive notice to Defendant of MAJOR's rights in and to the OPTIMUMWIRE mark.

9. If Defendant obtains rights as conferred under the Principal Register of the Trademark Act of 1946, it will obtain at least a *prima facie* exclusive right to use its alleged mark, and MAJOR will be subjected to great and irreparable damage, and Defendant will enjoy unlawful gain, and advantage to which it is not entitled under the Trademark Act of 1946.

WHEREFORE, MAJOR believes and avers that it is being, and will continue to be,

damaged by registration of the OPTIDUR mark, and prays that said U.S. Application Serial No. 79/064920 be rejected, that no registration be issued thereon to Defendant, and that the Opposition be sustained in favour of MAJOR.

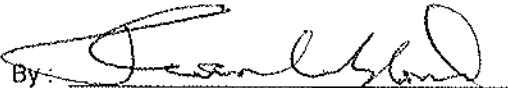
MAJOR hereby designate Jane F. Collen, a member of the Bar of New York and all of the law firm COLLEN IP INTELLECTUAL PROPERTY LAW, P.C., 80, South Highland Avenue, Ossining, Westchester County, New York, USA to act as Domestic Representative and on whom may be served notices or process in proceedings affecting the mark.

Please address all correspondence to:

Mrs. Jane F. Collen
COLLEN IP INTELLECTUAL PROPERTY LAW, P.C.
The Holyoke-Manhattan Building 80
80, South Highland Avenue
Ossining, Westchester County
New York, USA
NY 10562
Phone number: 914-941-5668
Fax number: 914-941-6091

The filing fee for this opposition, in the amount of US \$ 300.00, is hereby electronically transferred in the submission of the Notice of Opposition.

MAJOR WIRE INDUSTRIES
LTD. / LES INDUSTRIES FIL
MÉTALLIQUE MAJOR LTÉE

By: 

Jean Leblond, President
225, Blvd, Montcalm Nord
Candiac, Quebec Canada
J5R 3L6

Dated November 12, 2009

Encl.:

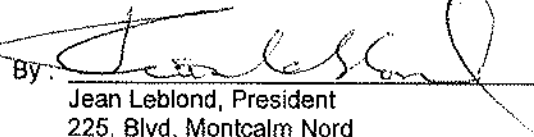
- Current printout - U.S. Registration # 2,606,393 (OPTIMUMWIRE mark) from the official electronic database records of the USPTO
- TARR Status - U.S. Registration # 2,606,393 (OPTIMUMWIRE mark)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing NOTICE OF OPPOSITION was served upon the following parties, at their address record, by sending same via Registered Mail, postage prepaid, on November 12, 2009.

Adam D. Siegartel, Attorney of record
PROSKAUER ROSE LLP
1585 Broadway
Trademark File Room
New York, NY
U.S.A. 10036-8299

MAJOR WIRE INDUSTRIES LTD. /
LES INDUSTRIES FIL MÉTALLIQUE MAJOR
LTÉE, Opposer

By: 
Jean Leblond, President
225, Blvd, Montcalm Nord
Candiac, Quebec
Canada
J5R 3L6

Dated November 12, 2009



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OptimumWire

Word Mark**Goods and Services****OPTIMUMWIRE**

IC 006. US 002 012 013 014 023 025 050. G & S: Wires made of metal and wires made primarily of metal alloys, plastics and composites, namely, straight wires, pre crimped wires and metal sections for use in the manufacture of wire netting, wire mesh, sifting screens, sieves and filters for sifting, filtering and sieving the rock, sable, gravel, minerals, and for use in the manufacture of various industrial products; woven wire screens of straight wire, pre-crimped wire, metal section made of metal and wires made primarily metal alloys, plastics and composites, namely, wire netting and wire mesh, sifting screens, sieves, filters for use of sifting, filtering and sieving the rock, sable, gravel, minerals used in the composition of various industrial products. FIRST USE: 19990115. FIRST USE IN COMMERCE: 19990115

IC 042. US 100 101. G & S: Custom manufacture of woven wire screens of straight wires, pre-crimped wire, metal section; wire netting, wire mesh, sifting screens, sieves, and filters for use in sifting, filtering or sieving the rock, sable, gravel, minerals, and used in the composition of various industrial products. FIRST USE: 19990115. FIRST USE IN COMMERCE: 19990115

Mark Drawing Code**Serial Number****Filing Date****Current Filing Basis****Original Filing Basis****Published for Opposition****Registration Number****Registration Date****Owner****Type of Mark****Register**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

75848117

November 12, 1999

1A

1A

May 21, 2002

2606393

August 13, 2002

(REGISTRANT) MAJOR WIRE INDUSTRIES LIMITED/LES INDUSTRIES FIL METALLIQUE MAJOR LIMITEE CORPORATION CANADA 225, BLVD. MONTCALM NORD CANDIAC QUEBEC J5R 3L6

TRADEMARK. SERVICE MARK

PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

| | | | | | | | |
|---------------------------|--------------------------|----------------------------|---------------------------|-----------------------------|---------------------------|---------------------|----------------------|
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Serial Number: 75848117 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2606393

Mark

OptimumWire

(words only): [OPTIMUMWIRE](#)

Standard Character claim: [No](#)

Current Status: [Section 8 and 15 affidavits have been accepted and acknowledged.](#)

Date of Status: [2008-09-13](#)

Filing Date: [1999-11-12](#)

Transformed into a National Application: [No](#)

Registration Date: [2002-08-13](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 114](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [830 -Post Registration](#)

Date In Location: [2008-09-13](#)

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [MAJOR WIRE INDUSTRIES LIMITED/LES INDUSTRIES FIL METALLIQUE MAJOR LIMITEE](#)

Address:

[MAJOR WIRE INDUSTRIES LIMITED/LES INDUSTRIES FIL METALLIQUE MAJOR LIMITEE](#)

225, BLVD. MONTCALM NORD
CANDIAC, QC J5R 3L6
Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

GOODS AND/OR SERVICES

International Class: 006

Class Status: Active

Wires made of metal and wires made primarily of metal alloys, plastics and composites, namely, straight wires, pre crimped wires and metal sections for use in the manufacture of wire netting, wire mesh, sifting screens, sieves and filters for sifting, filtering and sieving the rock, sable, gravel, minerals, and for use in the manufacture of various industrial products; woven wire screens of straight wire, pre-crimped wire, metal section made of metal and wires made primarily metal alloys, plastics and composites, namely, wire netting and wire mesh, sifting screens, sieves, filters for use of sifting, filtering and sieving the rock, sable, gravel, minerals used in the composition of various industrial products

Basis: 1(a)

First Use Date: 1999-01-15

First Use in Commerce Date: 1999-01-15

International Class: 042

Class Status: Active

Custom manufacture of woven wire screens of straight wires, pre-crimped wire, metal section; wire netting, wire mesh, sifting screens, sieves, and filters for use in sifting, filtering or sieving the rock, sable, gravel, minerals, and used in the composition of various industrial products

Basis: 1(a)

First Use Date: 1999-01-15

First Use in Commerce Date: 1999-01-15

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-09-13 - Section 8 (6-year) accepted & Section 15 acknowledged

2008-08-18 - Assigned To Paralegal

2008-08-08 - TEAS Section 8 & 15 Received

2008-01-11 - Case File In TICRS

2002-08-13 - Registered - Principal Register

2002-05-21 - Published for opposition

2002-05-01 - Notice of publication

2002-01-30 - Approved for Pub - Principal Register (Initial exam)

2002-01-23 - Examiner's amendment mailed

2001-12-27 - Petition To Revive-Granted

2001-03-26 - Petition To Revive-Received

2001-01-27 - Abandonment - Failure To Respond Or Late Response

2001-01-27 - Previous action count withdrawn

2000-04-06 - Non-final action mailed

2000-04-06 - Assigned To Examiner

2000-03-24 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

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WESTCHESTER COUNTY
80 SOUTH HIGHLAND AVENUE
OSSINING-ON-HUDSON, NY 10562

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